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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/822,349	04/02/2001	Yasuhisa Fujiwara	108198	1734

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OLIFF & BERRIDGE, PLC  
P.O. BOX 19928  
ALEXANDRIA, VA 22320

EXAMINER

MOONEYHAM, JANICE A

ART UNIT	PAPER NUMBER
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3629

MAIL DATE	DELIVERY MODE
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07/16/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

09/822,349

Applicant(s)

FUJIWARA, YASUHISA

Examiner

Janice A. Mooneyham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 and 18-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 18-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This is in response to the applicant's communication filed on April 16, 2007, wherein:

Claims 1-12 and 18-21 are currently pending;

Claims 1-2, 6, 11, and 18-21 have been amended.

#### ***Claim Rejections - 35 USC § 112***

2. The rejection of claims 1-12 and 18-21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement is withdrawn.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-12 and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by DeLorme et al (5,948,040) (hereinafter referred to as DeLorme).

DeLorme discloses a travel information providing center, comprising:

a display (Figure 1A (111);

a memory (Figures 3-4)

an input/output interface (Figure 2 (205, 227))

a controller coupled to the memory and the interface (Figure 2(209)).

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Claims 1-12 and 18 are directed to a center and a system. Claims to an apparatus must be distinguished from the prior art in terms of structure rather than function. A recitation directed to the manner in which a claimed apparatus is intended to be used does not distinguish the claimed apparatus from the prior art if the prior art has the capability to so perform. The Examiner asserts that the system of DeLorme is fully capable of storing information on locations, receiving a member ID, confirming if the member is registered, and searching for route information.

Furthermore, the limitations in many of the independent claims further describes the information being stored, not the structure of the center/system. Thus, the data being stored or transmitted is non-functional descriptive data, not functionally related to the structure of the center/system. The Examiner asserts that nonfunctional descriptive material cannot render nonobvious an invention that otherwise would have been obvious. *In re Ngai*, 367 F.3d 1336, 1339, 7- USPQ2d 1862, 1864 (Fed. Cir. 2004). *Cf. In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) (when descriptive material is not function related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-10, 18-19 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeLorme et al (5,948,040) (hereinafter referred to as DeLorme) in view of Lynch et al (6,018,715) (hereinafter referred to as Lynch).

Referring to Claims 1, 18-19 and 21:

DeLorme discloses method and system for providing user terminals with travel information, comprising:

storing in a memory information on registered members, purchase records of the registered members, and information on locations (Places) (Figure 4 (411, 417, 419, 415), Figure 8A (806) User/Member List), Figure 8B (842) (Client (Registered Member/User) (852) (User/Member Registration));

receiving at a terminal with an input/output interface a member ID (Figure 1A) (111); col. 13, lines 31-34; col. 14, line 43 thru col. 15, lines 32; col. 17, lines 14-27));

confirming through a controller that the user is a registered member with a valid ID (col. 46, lines 17-25);

preparing travel information at a controller coupled to the memory and interface, wherein the controller confirms the registered member based on the received member ID and prepares travel/route information based on the information input by the registered user (Figure 8A (814); col. 17, lines 14-27; col. 37, lines 7-30; col. 46, lines 17-25 and lines 33-44; col. 60, line 38 thru col. 61, line 25); and

displaying the travel information provided by the center at the terminal (Figures 1A – 1C and col. 14, line 43 thru col. 15, line 32) );

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searching for places of interest after the route has been determined using stored information (col. 35, lines 18-23 and 34-47; col. 40, line 57 through col. 41, line 32 EOs)

While DeLorme discloses an invention with the capability to produce customized or individualized outputs that reflect and record selective usage of the TRIPS invention by different individuals (col. 11, lines 25-30) and kiosk information terminals linked to a central terminal (col. 14, line 66 thru col. 15, line 1), wherein the central service bureau can dispense TRIPS services via one or more distributed travel information kiosk terminals (col. 15, lines 22-24), Delorme does not explicitly disclose the travel/route information is base on the purchase records in combination with the information input by the registered user.

However, Lynch discloses a travel system that automatically retrieves and considers the traveler portfolio information from traveler portfolio 18 in database 14 in the process of determining a recommended travel plan, wherein the traveler portfolio information includes the air carriers, automobile rental agencies, or hotels preferred by the traveler, frequent flier or renter programs in which the traveler participates, and the traveler's seating and/or smoking preferences (col. 3, lines 39-48, col. 5, line 63 thru col. 6, line 6) (The Examiner considers traveler portfolio information to be purchase records).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate into the travel reservation system of DeLorme the traveler portfolio information to be used along with the user input to determine a recommended

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travel plan as taught in Lynch so as to generate a more satisfactory travel plan by balancing the retrieved traveler portfolio information and the received travel request information wherein the derived travel plan can be used as a guideline to book travel arrangements that fall with the parameters of the travel itinerary.

Delorme discloses a comprehensive travel planning service that can handle immediate requests from travelers en route or at remote locations, as well as contemplative advanced planning information (col. 11, lines 40-49), as well as optional waypoints and events or points of interest (col. 17, lines 14-43). The invention also can provide services via one or more distributed travel information kiosk terminals (col. 15, lines 14-32).

Referring to Claim 2:

DeLorme discloses wherein the information on the home of the member is stored in the memory; and the home of the member is set as a starting point on a route prepared by the controller as part of the travel information to be provided (col. 37, lines 10-20; col., 17, lines 44-49; col. 34, lines 26-56).

Referring to Claim 3:

DeLorme discloses the input/output interface receives key information for specifying information requested by the member from the user terminal (Figure 1a, col. 6, line 55 thru col. 7, line 1), and

the controller prepares the travel information based on the key information (col. 60, line 38 thru col. 26; col. 63, lines 37-43).

Referring to Claim 4:

DeLorme discloses wherein the key information is information on accommodation facilities and the controller selects accommodation facilities as part of the travel information to be provided (col. 8, lines 45-48).

Referring to Claim 5:

DeLorme discloses the key information is information on tourist facilities and the controller selects tourist facilities as part of the travel information to be provided (col. 8, lines 45-48; col. 41, lines 6-66 Events of Interest).

Referring to Claim 6:

DeLorme discloses wherein the input/output interface receives a destination of the user input through the user terminal, and the controller prepares information on a route from a starting point to a destination as part of the travel information to be provided (Figure 1a, col. 6, lines 8-46; col. 10, line 59 thru col. 11, line 2; col. 34, lines 45-56; col. 34, lines 26 thru col. 36, line 25).

Referring to Claim 7:

DeLorme discloses wherein the information on the route includes at least one of information on an entire route and information on particular areas along the route (col. 9, lines 3-18; col. 9, lines 19-64).

Referring to Claim 8:

DeLorme discloses wherein the controller prepares, upon confirmation that the member is registered, the travel information so as to include route information and information on locations of service providing facilities which are adjacent to the route



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and which are exclusively available to the member who has been identified based on the member information stored in the memory (Figure 2, Register Now, Figure 6, Figure 8a, Figure 8b, Figure 9A, col. 21, lines 27-52, col. 22, lines 38-61, col. 34, lines 24-56).

Referring to Claim 9:

DeLorme discloses a terminal that displays the travel information (Figure 1a (111 and 121, Figure 9B (907).

Referring to Claim 10:

DeLorme a medium that stores the travel information and a terminal that reads the travel information stored on the medium and displays the travel information (col. 7, lines 22-34, col. 13, line 31 thru col. 17, line 13).

5. Claims 11-12 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeLorme in view of Lynch and further in view of Bellesfield et al (US 6,282,489) (hereinafter referred to as Bellesfield).

DeLorme discloses a system and method of providing travel information comprising:

storing in a memory information on locations (places) (Figure 4 (411, 417, 419, 415), Figure 8A (806) User/Member List), Figure 8B (842) (Client (Registered Member/User) (852) (User/Member Registration))

receiving a member ID through an input/output interface (Figure 1A) (111); col. 13, lines 31-34; col. 17, lines 14-27));

confirming a registered member based on the member ID via a controller (Figure 8A (814); col. 17, lines 14-27; col. 37, lines 7-30; col. 46, lines 17-25 and lines 33-44; col. 60, line 38 thru col. 61, line 25);

providing travel information including a route from a starting point to a destination based on the information input by the member (col. 18, line 65 thru col. 19, line 8);

providing route information as travel information to a user upon confirmation of the registered member (Figure 8A (814); col. 17, lines 14-27; col. 37, lines 7-30; col. 46, lines 17-25 and lines 33-44; col. 60, line 38 thru col. 61, line 25).

While DeLorme discloses an invention with the capability to produce customized or individualized outputs that reflect and record selective usage of the TRIPS invention by different individuals (col. 11, lines 25-30) and kiosk information terminals linked to a central terminal (col. 14, line 66 thru col. 15, line 1), wherein the central service bureau can dispense TRIPS services via one or more distributed travel information kiosk terminals (col. 15, lines 22-24), Delorme does not explicitly disclose the travel/route information is base on the purchase records in combination with the information input by the registered user.

However, Lynch discloses a travel system that automatically retrieves and considers the traveler portfolio information from traveler portfolio 18 in database 14 in the process of determining a recommended travel plan, wherein the traveler portfolio information includes the air carriers, automobile rental agencies, or hotels preferred by the traveler, frequent flier or renter programs in which the traveler participates, and the traveler's seating and/or smoking preferences (col. 3, lines 39-48, col. 5, line 63 thru

col. 6, line 6) (The Examiner considers traveler portfolio information to be purchase records).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate into the travel reservation system of DeLorme the traveler portfolio information to be used along with the user input to determine a recommended travel plan as taught in Lynch so as to generate a more satisfactory travel plan by balancing the retrieved traveler portfolio information and the received travel request information wherein the derived travel plan can be used as a guideline to book travel arrangements that fall with the parameters of the travel itinerary.

DeLorme does not disclose storing information on locations of information providing terminals installed at various locations and providing information on the locations of the information providing terminals which are installed adjacent to a selected route that is to be traveled.

However, Bellesfield discloses storing information on locations of interest installed at various locations and providing information on the locations of the places of interest which are installed adjacent to a selected route that is to be traveled (abstract) (Figure 11 (176)). An ATM is considered a point/place of interest (see Yokota US 6,405,129 col. 1, lines 31-52). The Examiner considers an ATM to be an information terminal.

Therefore, it would have been obvious to one of ordinary skill in the art to incorporate into the travel planning system of DeLorme the list of places of interest located near a calculated travel route between a departure point and a destination

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taught in Bellesfield so that the individual has easy access to information of interest, such as hotels, restaurants, and attractions along the route without going through a time consuming process of determining which places of interest are geographically located near the route.

### ***Response to Arguments***

Applicant's arguments filed on April 16, 2007 have been fully considered but they are not persuasive.

In response to applicant's argument that DeLorme and Lynch fail to disclose or suggest that a controller that prepares travel information in order to display a route from a starting point to a destination on a display based on information input by the registered member and searches for places of interest after the route has been determined using purchase records of the registered member as recited in claims 1 and similarly recited in claims 18, 19, and 21. As set forth above, independent claims 1, 11, and 18 are systems or apparatus claims. A recitation directed to the manner in which a claimed apparatus is intended to be used does not distinguish the claimed apparatus from the prior art if the prior art has the capability to so perform.

As for applicant's argument that DeLorme does not searching for places of interest after the route has been determined, the Examiner respectfully disagrees and directs the applicant to col. 40, line 57 through col. 41, line 32).

Moreover, as set forth previously, the Examiner considers information about the purchase of an airline ticket, seating preferences or the hotel preferences to be a purchase record used to determine a travel plan.

In response to applicant's arguments against the Bellesfield reference individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642

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F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

DeLorme discloses kiosk information terminals linked to a central terminal (col. 14, line 66 thru col. 15, line 1), wherein the central service bureau can dispense TRIPS services via one or more distributed travel information kiosk terminals (col. 15, lines 22-24). Bellesfield discloses storing information on locations of interest installed at various locations and providing information on the locations of the places of interest which are installed adjacent to a selected route that is to be traveled (abstract) (Figure 11 (176). An ATM is considered a point/place of interest (see Yokota US 6,405,129 col. 1, lines 31-52). The Examiner considers an ATM to be an information terminal. Lynch discloses a travel system that automatically retrieves and considers the traveler portfolio information from traveler portfolio 18 in database 14 in the process of determining a recommended travel plan, wherein the traveler portfolio information includes the air carriers, automobile rental agencies, or hotels preferred by the traveler, frequent flier or renter programs in which the traveler participates, and the traveler's seating and/or smoking preferences (col. 3, lines 39-48, col. 5, line 63 thru col. 6, line 6) (The Examiner considers traveler portfolio information to be purchase records). Thus, the Examiner asserts that DeLorme in combination with Lynch and Bellesfield disclose the limitations of claims 11, 12, and 20.

***Conclusion***

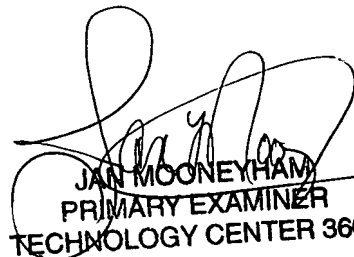
Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janice A. Mooneyham whose telephone number is (571) 272-6805. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
JAN MOONEYHAM  
PRIMARY EXAMINER  
TECHNOLOGY CENTER 3600